

PATENT APPLICATION

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES**

In re application of

Docket No: Q64273

Akira ICHIKAWA, et al.

Appln. No.: 09/830,605

Group Art Unit: 1771

Confirmation No.: 9350

Examiner: Victor S. CHANG

Filed: April 30, 2001

For: ADHESIVE LABEL

REPLY BRIEF PURSUANT TO 37 C.F.R. § 41.41

MAIL STOP APPEAL BRIEF - PATENTS

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

In accordance with the provisions of 37 C.F.R. § 41.41, Appellant respectfully submits this Reply Brief in response to the Examiner's Answer dated June 15, 2007. Entry of this Reply Brief is respectfully requested.

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STATUS OF CLAIMS

As mentioned in the Appeal Brief filed April 16, 2007, claims 1, 2, and 4-14 are pending.

Also as mentioned in the Appeal Brief filed April 16, 2007, this is an appeal from the Examiner's sole rejection of claims 1, 2, and 4-14 under 35 U.S.C. § 103(a) based on Tanimura et al. (U.S. Patent No. 6,065,701) (hereinafter "Tanimura") in view of Applicants' alleged admission.

GROUND OF REJECTION TO BE REVIEWED ON APPEAL

Appellant seeks review and reversal of the Examiner's rejection of claims 1, 2, and 4-14 under 35 U.S.C. § 103(a) based on Tanimura et al. (U.S. Patent No. 6,065,701) (hereinafter "Tanimura") in view of Applicants' alleged admission.

In the Examiner's Answer of June 15, 2007, the Examiner raises two issues that Appellant considers it necessary to address:

- First, the Examiner has taken the novel position that "applicants' admission *as a whole*" (see page 5, line 5 of the Examiner's Answer) (emphasis added) renders obvious those elements of the present claims that the Examiner apparently did not discover in the prior art.
- Second, the Examiner appears to misunderstand the Declaration evidence that supports Appellant's position of unexpected superior results.

ARGUMENT

Appellant respectfully submits that (1) the Examiner's new characterization of Appellant's "admission" is no more tenable than the Examiner's previous characterization of Appellant's "admission;" and (2) the Declaration evidence supports a finding of unexpected superior results because it illustrates that the present invention provides for "printability sufficient from a practical standpoint... wherein the entire thickness is thinnest" (see, e.g., page 23, first full paragraph of the Appeal Brief filed April 16, 2007).

1. The Examiner's new characterization of appellant's alleged "admission" is unsupported

In the Examiner's Answer, the Examiner appears to have broadened his definition of Appellant's alleged "admission" and relies upon the "admission" as a crutch to provide those elements of the claims that the Examiner apparently did not discover during his search of the prior art.

In the Office Action of August 15, 2006, the Examiner asserted that Appellant's alleged admission was that "it is known that the data carrier element containing IC chip can be formed on either side of substrate and functions equivalently" (see page 3 of the Office Action mailed August 15, 2006). In light of Appellant's arguments set forth in the Appeal Brief, the Examiner's new assertion is that Appellant's alleged admission is that "the electronic components of the data carrier element may be formed on either side of the circuit substrate entirely or partially, and

these alternative arrangements functions [sic] equivalently” (see page 5 of the Examiner’s Answer).

The Examiner does not appear to point to any new evidence or any different passages of Appellant's specification to support this new characterization of Appellant's alleged "admission." Therefore, Appellant respectfully submits that the new (expanded), broader characterization of Appellant's alleged "admission" is unsupported by the present specification, and is not a suitable basis upon which to rely to provide those elements of the present claims that apparently were not discovered during the Examiner's search of the prior art.

2. The Examiner has misunderstood the Declaration evidence

Appellant submitted in the Appeal Brief that the Declaration evidence illustrates the unexpected remarkable effects obtained by the present invention, which includes printability sufficient from a practical standpoint wherein the entire thickness is thinnest (see, e.g., page 23, first full paragraph of the Appeal Brief). Therefore, the unexpected remarkable effects of the present invention are the printability of the invention in combination with the thinness of the invention.

In dismissing the Declaration evidence, the Examiner appears to have misunderstood the nature of the unexpected remarkable effects of the present invention by ignoring the thinness


aspect of the invention, as illustrated in the Declaration. The Examiner asserted on page 6 of the Examiner's Answer that "since the Declaration shows that Comparative Experiment C has better printability than Experiment A, the present invention does not necessarily have a superior printability." However, as discussed above, Appellant's argument regarding unexpected results is not that the present invention has a superior printability, but that the present invention has a superior printability in combination with its thinness. The Examiner has apparently overlooked the fact that the contactless data carrier element of Comparative Experiment C is considerably thicker than the contactless data carrier element of Experiment A (see Table 1, page 21 of the Appeal Brief).

Accordingly, Appellant reiterates Appellant's position that the present Declaration evidence supports a finding of the unexpected remarkable effects of the present invention, sufficient to overcome the cited prior art.

CONCLUSION

For the above reasons, as well as the reasons set forth in Appeal Brief, Appellant respectfully requests that the Board reverse the Examiner's rejections of all claims on Appeal. An early and favorable decision on the merits of this Appeal is respectfully requested.

Respectfully submitted,


Joseph F. Ruch, Jr.
Registration No. 26,577

SUGHRUE MION, PLLC
Telephone: (202) 293-7060
Facsimile: (202) 293-7860

WASHINGTON OFFICE

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